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July 6, 2007

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Commissioner for Patents  
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**Art Unit 1639**

**Attn: Mail Stop Appeal Brief - Patents**

Re: U.S. Utility Patent Application  
Application No. 09/987,456; Filed: November 14, 2001  
For: ***In Vitro* Methods of Producing and Identifying Immunoglobulin  
Molecules in Eukaryotic Cells**  
Inventors: ZAUDERER *et al.*  
Our Ref: 1821.0070004/EJH/T-M

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply to Notification of Non-Compliant Appeal Brief;
2. Amended Brief on Appeal Under 37 C.F.R. § 41.37 with Supplemental Arguments under 37 C.F.R. § 41.37(c)(1)(vii); and
3. Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier.

In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents

July 6, 2007

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The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "Tracy L. Muller". The signature is fluid and cursive, with the first name "Tracy" and last name "Muller" clearly distinguishable.

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T-M/ybh/tc  
Enclosures

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of:

ZAUDERER *et al.*

Application No.: 09/987,456

Filed: November 14, 2001

For: ***In Vitro* Methods of Producing and  
Identifying Immunoglobulin  
Molecules in Eukaryotic Cells**

Confirmation No.: 6770

Art Unit: 1639

Examiner: Epperson, Jon D.

Atty. Docket: 1821.0070004/EJH/T-M

**Reply to Notification of Non-Compliant Appeal Brief**

***Attn: Mail Stop Appeal Brief - Patents***

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the Notification of Non-Compliant Appeal Brief, Appellants submit the following Amended Appeal Brief and Remarks. The required brief filing fee of \$250.00 under 37 C.F.R. §41.37 for a small entity was submitted with Appellants' filing on April 27, 2007. It is not believed that any additional fees are required. However, if additional fees are necessary to prevent abandonment of this application, then such are hereby authorized to be charged to our Deposit Account No. 19-0036.

The Amended Appeal Brief also contains supplemental arguments under 37 C.F.R. §41.37(c)(1)(vii), to address the United States Supreme Court's decision in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), which was rendered after Appellants filed their original Brief on Appeal on April 27, 2007. It is Appellants' understanding based on information received from representatives at the Board of Patent Appeals and Interferences that, since an Examiner's Answer has not yet been submitted,

it is appropriate to include the supplemental arguments section in the Amended Brief on Appeal.<sup>1</sup>

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<sup>1</sup> In particular, Appellants would like to thank Ms. Tina Lee at the Board of Patent Appeals and Interferences for confirming this information with Appellants' representative by telephone on July 6, 2007.

***Remarks***

The Notification of Non-Compliant Appeal Brief mailed on June 6, 2007, states that Appellants' Brief filed on April 27, 2007 "does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii))." Specifically, the Office states that "[t]he status of all claims on appeal has not been identified." In response, Appellants have amended the "Status of the Claims" section of the Brief to clearly indicate the status of all claims on appeal. In addition, Appellants have added claim status identifiers to the "Claims Appendix". Appellants note, however, that in accordance with 37 C.F.R. § 41.37(c)(1)(viii), the amended "Claims Appendix" contains only the claims on appeal (*i.e.*, not claims that are withdrawn or canceled).

Appellants have also amended the "Status of Amendments" section to indicate that an Amendment was filed on April 27, 2007. The original language as filed in the Appeal Brief of April 27, 2007, indicated that an amendment "is filed herewith."

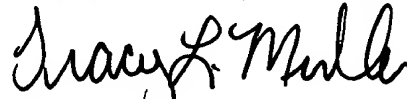
The Amended Brief on Appeal submitted herewith also contains an amended Arguments section to address recent changes in the law. In particular, on April 30, 2007, the United States Supreme Court issued a decision in the case of *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), providing a new interpretation of the law as it pertains to determining obviousness. The Arguments section been amended to include an updated Legal Principles section and a Supplemental Arguments section in view of the recent caselaw. Since the main ground of rejection of the claims on appeal is for alleged obviousness, Appellants believe that this Amended Brief on Appeal, presenting

additional arguments in view of *KSR* and subsequent Federal Circuit decisions, is filed with just cause under 37 C.F.R. § 41.37(c)(1)(vii).

Accordingly, all of the stated grounds of non-compliance have been properly accommodated or rendered moot. Appellants therefore respectfully request that the attached Amended Appeal Brief be entered.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Tracy L. Muller  
Attorney for Applicants  
Registration No. 55,472

Date: July 6, 2007

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

ZAUDERER *et al.*

Appl. No. 09/987,456

Filing date: November 14, 2001

For: ***In Vitro* Methods of Producing  
and Identifying Immunoglobulin  
Molecules in Eukaryotic Cells**

Confirmation No.: 6770

Art Unit: 1639

Examiner: Epperson, J.D.

Atty. Docket: 1821.0070004/EJH/T-M

**Amended Brief on Appeal Under 37 C.F.R. § 41.37 with Supplemental  
Arguments under 37 C.F.R. § 41.37(c)(1)(vii)**

***Mail Stop Appeal Brief - Patents***

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal from the final rejection of claims 84, 88-97, 99, 103, 107-122, and 127-131 was filed on January 31, 2007. A Brief on Appeal Under 37 C.F.R. § 41.37; a Petition for Extension of Time Under 37 C.F.R. 1.136(a); and an Amendment Under 37 C.F.R. § 41.33 (b) were filed with the appropriate fees on April 27, 2007.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.



ZAUDERER *et al.*  
Appl. No. 09/987,456

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***I. Real Parties in Interest***

The real parties in interest in this appeal are the University of Rochester and Vaccinex, Inc. The University of Rochester is the assignee of the present invention by virtue of an assignment from the inventors to Vaccinex, LP (now Vaccinex, Inc.), executed on January 24, 2002, and recorded against the present application on February 7, 2002, beginning at reel 012375/frame 0199; and an assignment from Vaccinex, LP to the University of Rochester, executed on January 24, 2002, and recorded against the present application on February 7, 2002, beginning at reel 012375/frame 0223. Vaccinex, Inc. is the exclusive licensee of the present invention by virtue of an agreement with the University of Rochester.

***II. Related Appeals and Interferences***

There are no prior or pending appeals, interferences or judicial proceedings known to Appellant or the Appellant's legal representative which may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision in the present Appeal.

***III. Status of Claims***

Claims 1-83, 123-126, and 127-128\* have been canceled.

Claims 84, 88-97, 99, 103, 107-122, and 129-131 are rejected.

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\* Claims 127 and 128 were canceled in an Amendment under 37 C.F.R. § 41.33(b), filed on April 27, 2007.

Claims 85-87, 98, 100-102, and 104-106 have been withdrawn from consideration, but remain pending.

Claims 84, 88-97, 99, 103, 107-122, and 129-131 are presently on appeal. A copy of the claims on appeal can be found in the Claims Appendix.

#### ***IV. Status of Amendments***

In an Amendment under 37 C.F.R. § 41.33(b), filed on April 27, 2007, Appellants requested that claims 127 and 128 be canceled.

#### ***V. Summary of Claimed Subject Matter***

##### ***A. Overview of Claimed Subject Matter***

Claim 84 is the sole independent claim involved in this appeal. The invention defined by claim 84 relates generally to a method of selecting polynucleotides that encode an antigen-specific human immunoglobulin molecule. The method of claim 1 comprises, *inter alia*, introducing into mammalian host cells: (1) a library of polynucleotides encoding immunoglobulin subunit polypeptides comprising a heavy chain (or light chain) variable and constant region, and (2) a library of polynucleotides encoding immunoglobulin subunit polypeptides comprising a light chain (or heavy chain) variable and constant region, and permitting expression of immunoglobulin molecules from the host cells. The libraries of polynucleotides are constructed in vaccinia virus vectors. If the immunoglobulin molecule is able to specifically bind to an antigen of interest, the vaccinia virus vectors containing the polynucleotides from the first library are recovered. By this method, one can identify from a library of polynucleotide molecules those that encode an immunoglobulin subunit polypeptide

comprising a heavy or light chain variable region that is capable of binding to a specific antigen. Support for claim 84 can be found throughout the Specification as filed, for example, at paragraphs [0013]-[0024], [0025]-[0029], [0048]-[0050], [0053]-[0062], [0067]-[0069], [0071]-[0075], [0078]-[0083], [0089]-[0102], [0109]-[0112], [0119]-[0125], [0131]-[0132], [0156], and Examples 1-3, and 18.

***B. Advantages of the Present Invention***

At the time of the present invention, there were general strategies to produce immunoglobulin molecules that could recognize "self" (e.g., human) antigens and therefore be used for therapeutic and diagnostic purposes. See Specification as filed at paragraphs [0003]-[0005]. According to the first strategy, antibodies against such antigens could be raised in rodents. *Id.* However, such rodent antibodies would not be desirable for use in humans, for example, because they could elicit an immune response as a foreign protein. *Id.* Therefore, the antigen binding regions from the rodent antibody could be grafted onto the framework region of a human antibody, a process known as "humanization." *Id.* at paragraph [0005]. However, humanization can diminish binding affinity of the antibody for the target antigen, which can require costly and laborious work to restore. *Id.*

The second strategy uses immunization of transgenic mice that express human immunoglobulin sequences to select an antibody against the antigen of interest. *Id.* at paragraph [0006]. Although the antibodies are derived from sequences that are "human," they may be subject to problem known as "tolerance" which occurs when the human protein against which antibodies are sought has a mouse homologue. When the mouse produces antibodies to the human protein, the antibodies may be biased toward

recognizing epitopes that are different between the human and mouse because the mouse will not produce antibodies to epitopes found in its own proteins. *See id.* The drawback is that the “unique” epitopes may not be the optimal targets. *Id.*

The third general strategy is an *in vitro* screening approach, whereby bacterial host cells are infected with bacteriophage particles harboring nucleic acids that encode immunoglobulin fragments fused to a bacteriophage surface protein. *Id.* at paragraph [0007]. When these fusion proteins are expressed, the immunoglobulin fragments are displayed on the surface of the bacteriophage, attached by the surface protein. *Id.* This allows for the displayed immunoglobulin fragments to be screened for those fragments that bind an antigen of interest and allows the nucleic acid encoding the immunoglobulin fragment to be recovered. *Id.* However, phage display only results in the expression of a fragment of an antibody, requiring that, the antibody fragment be re-cloned for use as a full antibody. *Id.* at paragraph [0008]. Furthermore, there are different selective filters imposed on the antibodies selected from phage display methods because the antibody fragments may fold differently when expressed as phage fusion proteins than they do when removed from the phage context and expressed as whole antibodies, and because the antibodies do not undergo eukaryotic post-translational modifications. *See id.* at paragraphs [0008]-[0009].

The present invention provides for the direct identification, in mammalian cells, of antigen-specific, fully human antibodies. Such fully human antibodies would be expected to have a lower incidence of immune rejection when used as therapeutics than would fully murine or humanized antibodies. In addition, antibodies identified by the claimed methods do not have to be re-engineered for use as full-length immunoglobulins,

unlike antibody fragments isolated from phage display, since the claimed invention provides for direct expression and selection of whole antibodies, with normal post-translational modifications. The present invention further provides the ability to achieve extremely high levels of combinatorial diversity of human immunoglobulin heavy and light chains *in eukaryotic cells*, which results in an increased likelihood of identifying antibodies with high-affinity, high specificity, and desired functions.

Another advantage of the present invention is the ability to directly select antibodies that would otherwise be difficult or impossible to identify with other antibody selection systems. For example, selecting antibodies via phage display is not generally suitable for use in screening for antibodies that bind to membrane-associated proteins. Such proteins are generally difficult to purify and, therefore, antibodies with specificity for such proteins must usually be screened using whole cells or cell membrane fragments. However, phage particles have non-specific interactions with mammalian cells and thereby interfere with the antibody screening process.

In another example, the present invention overcomes the problem of "tolerance" that occurs when selecting antibodies from transgenic mice because the method is performed *in vitro* and there are no species homologues of the antigen that might result in bias toward antibodies that bind less preferred epitopes. Thus, the present invention provides numerous important and distinct advantages over the previously available antibody selection technologies such as phage display and transgenic mice.

#### ***VI. Grounds of Rejection to be Reviewed on Appeal***

There are two separate grounds of rejection to be reviewed on Appeal:

- (1) ***Rejection Under 35 U.S.C. § 103:*** Whether the subject matter of claims 84, 88-97, 99, 103, 107-122, and 127-131 would have been obvious over Rowlands *et al.*, WO 93/01296 ("Rowlands") (Exhibit 1) in view of Zauderer, WO 00/28016 ("Zauderer") (Exhibit 2) and Waterhouse *et al.*, *Nuc. Acids Res.* 21: 2265-66 (1993) ("Waterhouse") (Exhibit 3). Appellants respectfully traverse this rejection.
- (2) ***Rejection for Obviousness-type Double Patenting:*** Whether the subject matter of claims 84, 88-97, 99, 103, 107-122, and 127-131 is unpatentable under the judicially-created doctrine of obviousness-type double patenting over claims 1-84 of U.S. Patent Application No. 10/052,942 ("the '942 application"), in view of Rowlands, or over claims 46-128 of U.S. Patent Application No. 10/465,808 ("the '808 application"), in view of Rowlands and Zauderer. Appellants respectfully traverse these rejections.

## ***VII. Argument***

### ***A. The Claimed Methods Would Not Have Been Obvious Over the Cited References***

#### ***1. Legal Principles Relating to Nonobviousness***

An obviousness determination under 35 U.S.C. § 103 is carried out according to the standard set forth by the United States Supreme Court in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, (1966):

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of

ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

*Id.* at 17-18.

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *See In re Piasecki*, 745 F.2d 1468, 1471-73, 223 USPQ 785, 788 (Fed. Cir. 1984). To meet this burden, the Examiner must satisfy three requirements. First, all of the claim limitations must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *see also In re Glaug*, 283 F.3d 1335, 1341-42, 62 USPO2d 1151, 1154 (Fed. Cir. 2002); *In re Rijckaert*, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine references. *See In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Third, there must be a reasonable expectation of success. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Furthermore, the following tenets of patent law must be followed when applying 35 U.S.C. § 103:

(1) the claimed invention must be considered as a whole...; (2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination...; (3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention...; [and] (4) "ought to be tried" is not the standard with which obviousness is determined ...

*Hodosh v. Block Drug Co., Inc.* 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 188 n.5 (Fed. Cir. 1986). "[I]t is insufficient to merely identify each element in the prior art to establish unpatentability of the combined subject matter as a whole." *Sanofi-Synthelabo v. Apotex*, 470 F.3d 1368, 1370, 81 USPQ2d 1097, 1104 (Fed. Cir. 2006) (citing *Abbott Labs. v. Andrx Pharm., Inc.*, 452 F.3d 1331, 1336 (Fed Cir. 2006)).

The United States Supreme Court recently addressed the issue of obviousness in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). In *KSR*, the Court determined that, while it should not be applied as a rigid rule, the teaching-suggestion-motivation ("TSM") approach to an obviousness inquiry is not inconsistent with an obviousness analysis under *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966). See *KSR*, 127 S.Ct. at 1741. Indeed, the Court stated that the TSM analysis provides a helpful insight by recognizing that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently known in the prior art." *Id.* Rather, there must be a reason or rationale behind an obviousness determination and "this analysis should be made explicit." *Id.* at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some



articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.")). Hence, *KSR* is fully consistent with the legal principles set forth above.

Furthermore, the Federal Circuit also recently confirmed that "the Court acknowledged the importance of identifying 'a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does' in an obviousness determination." *Takeda Chemical Industries, Ltd. v. Alphapharm PTY., LTD*, No. 06-1329, slip op. at 15 (Fed. Cir. 2007). In *Takeda*, the Federal Circuit affirmed the district court's holding of non-obviousness of a claim to a chemical compound, finding that 1) there was no motivation based on the prior art as a whole to modify the closest prior art compound and arrive at the claimed compound, *id.* at 13-16; and 2) even if there had been a reason in the art to make the modification, the evidence indicated that there was no reasonable expectation of success in achieving the claimed invention. *Id.* at 17-18. Thus, without a reasonable expectation of success in modifying the prior art, the claimed invention was not obvious.

## **2. Summary of the Examiner's Basis for the Obviousness Rejection**

The Examiner alleges that claims 84, 88-97, 99, 103, 107-122, and 127-131 would have been obvious over Rowlands in view of Zauderer and Waterhouse. The Examiner's position is that the skilled artisan would have been motivated to use Rowlands' method of expressing single, isolated antibody heavy and light chains and to use Zauderer's method of screening a single library of tumor antigens in mammalian cells to make and screen immunoglobulin heavy and light chain libraries as taught in Waterhouse for prokaryotic host cells. See Office Action dated October 31, 2006 (referred to herein as "the 10/31/06 Office Action"), at pages 8-10. According to the

Examiner, there would have been a reasonable expectation of success because both Rowlands and Zauderer discuss the use of vaccinia virus vectors in mammalian cells, and Waterhouse discloses examples of associated heavy and light chains that can be used for screening and/or antibody maturation in bacteria. *See id.* at pages 3 and 9-10. As explained below, this justification for the rejection is factually flawed and legally insufficient to establish a *prima facie* case of obviousness.

### **3. Summary of Cited References**

#### **(a) Rowlands**

Rowlands discloses the introduction of vaccinia virus expression vectors containing the heavy and light chain sequences of a particular, preselected antibody, Campath-1H. Campath-1H is a humanized antibody that binds to CDw52. Campath-1H was generated by grafting the antigen-specific complementarity determining regions (CDRs) of the rat Campath-1G monoclonal antibody onto a human immunoglobulin framework. The Rowlands method is concerned with developing an expression system to increase the yield of a known antibody, preferably a humanized antibody such as Campath-1H. *See* Rowlands at page 3, line 19 to page 4, line 5 and page 8, line 24 to page 9, line 2.

#### **(b) Zauderer**

Zauderer discloses a method for identification of target antigens recognized by cytotoxic T cells. The Zauderer method generates a single library of vaccinia virus vectors to express tumor, cancer, or infected cell-specific antigens, which are then screened with cytotoxic T cells to identify reactive target antigens. The reactive antigens

can be used as immunogenic compositions or vaccines. *See, e.g.,* Zauderer at cover page (Abstract) and at page 14, line 19 to page 15, line 6.

**(c) Waterhouse**

Waterhouse discloses a method of using *lox*-Cre regulated site-specific recombination to pair heavy and light chain genes from different replicons into a single bacteriophage-infected bacterial host. Waterhouse at page 2265, column 1. The premise behind the Waterhouse method was to introduce two bacteriophage vectors into *E. coli* bacterial host cells. The first vector was an “fd phage acceptor vector” encoding a light chain fragment of a “first” antibody (specifically, an anti-phOx antibody), and a heavy chain fragment of a “second,” different antibody (specifically, an anti-TNF- $\alpha$  antibody). *Id.* The second vector was a “donor vector” encoding the heavy chain fragment of the “first” antibody (*i.e.*, the anti-phOx antibody). Both vectors contained *loxP* sites which, in the presence of Cre recombinase that was also introduced into the bacterial host cells, could recombine to generate chimeric plasmids. *Id.* at column 1-2. As a result of the recombination event, the plasmids could exchange heavy chain fragments to yield plasmids with the light and heavy chain fragments of the first antibody (*i.e.*, a complete anti-phOx Fab fragment), and plasmids with only the heavy chain fragment of the second (*i.e.*, an anti-TNF- $\alpha$  heavy chain). *Id.* at column 2. The acceptor vector also encoded the phage gene 3 protein (g3p) as a fusion protein with the anti-phOx Fab fragment so that the antibody fragment was displayed on the surface of the phage particles produced by the *E. coli* host cell. *Id.* 2265, column 2 and at page 2266, Figure 1. Waterhouse proposed that the method could be used to make a combinatorial library by providing a light chain fragment repertoire in the first vector and a heavy chain fragment repertoire

in the second vector and allowing them to recombine. *Id.* at page 2666, column 1. However, they did not actually perform the method using antibody repertoires in this reference.

**4. Claims 84, 88-97, 99, 103, 107-122, and 127-131 Would Not Have Been Obvious over the Cited References**

**(a) There Was No Reasonable Expectation of Success in Combining the Cited References**

One of ordinary skill in the art would not have been motivated to combine Rowlands with Zauderer and Waterhouse with a reasonable expectation of success. The Examiner's position is that,

one of ordinary skill in the art would have reasonably expected to be successful because Zauderer *et al.* teach several successful examples of library formation using the same vaccinia virus vectors that are disclosed by Rowlands *et al.* and Waterhouse *et al.* teach several successful examples of associated light/heavy chains that can be used for screening and/or antibody maturation, which would encompass the heavy/light chain antibodies disclosed by Rowlands *et al.*

*See* 10/31/06 Office Action at page 10. However, the Examiner's conclusion is based on erroneous assumptions made without a supporting scientific rationale and is legally and factually flawed.

As discussed above, Rowlands discloses the expression of vaccinia virus vectors containing the heavy and light chains of the pre-selected humanized Campath-1H antibody. Zauderer discloses a method of screening one vaccinia virus expression library of tumor antigens with cytotoxic T cells. Waterhouse discloses the expression of antibody heavy and light chain fragments in a combinatorial phage display library in

bacteria. Even assuming, *arguendo*, that one of ordinary skill in the art would know in view of Rowlands how to express a *single* antibody, and would know in view of Zauderer how to make and screen a *single* vaccinia virus expression library, it does not follow that the skilled artisan could, with a reasonable expectation of success, arrive at a method of selecting polynucleotides encoding antigen-specific immunoglobulins by introducing *two* libraries of vaccinia virus vectors into mammalian host cells. This is so, even in view of Waterhouse, because the Waterhouse method is performed in a completely different biological system than the Rowlands and Zauderer methods.

As evidence that one of skill in the art would not have had a reasonable expectation of success, Appellants point to the Declaration of Dr. Walter J. Storkus ("Storkus Declaration"), filed with the reply on July 21, 2005 (submitted herewith as Exhibit 4). Dr. Storkus is an expert in immunology and was a member of the Scientific Advisory Board (SAB) of Vaccinex, Inc.<sup>†</sup>, at the time the present application was filed. *See* Storkus Declaration. As an SAB member, Dr. Storkus evaluated the claimed technology contemporaneously with the filing of the present application and, therefore, was able to provide an account of his thoughts about the invention *at that time*. Dr. Storkus opined that, at the time, he did not think there was a reasonable expectation of success and he provided specific reasons why he considered phage display methods, such as those disclosed in Waterhouse, to be of limited instructive value for a eukaryotic immunoglobulin screening method. *Id.* at paragraphs 7-9. Because of the different ways in which prokaryotic and eukaryotic expression systems work and the complexity of getting randomly expressed immunoglobulin heavy and light chains from two different

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<sup>†</sup> Vaccinex, Inc., is the exclusive licensee of the present invention.

libraries to associate, Dr. Storkus stated that, even in view of the cited references, at the time the present application was filed, he would not have expected to achieve success with the claimed invention. *Id.* Furthermore, Dr. Storkus indicated that a eukaryotic cell system was thought to be impractical for screening a sufficient number of eukaryotic cells to find an antibody that had specificity for a specific antigen of interest. *Id.* at page 3. Hence, the limits on the ability to screen eukaryotic host cells as opposed to phage particles would have been considered an obstacle to the reasonable expectation of success in arriving at the claimed methods by combining Rowlands with Zauderer and Waterhouse.

The Examiner erred by disregarding the Storkus Declaration without providing sound legal or factual bases for doing so. The Examiner erred legally by substituting his opinion for that of an expert without providing any countervailing evidence to support his conclusion. *See In re Zeidler*, 682 F.2d 961, 966-67, 215 USPQ 490, 494 (C.C.P.A. 1982) (holding that the decision of the Board of Patent Appeals and Interferences constituted reversible error, "the board having erroneously substituted its judgment for that of an established expert in the art."). For example, the Examiner relies on Waterhouse to show "that the production of two libraries ... will lead to more favorable antibodies via a co-selection process, regardless of how those antibodies are produced," 10/31/06 Office Action at page 30 (emphasis in original), and has asserted that "the prokaryotic/eukaryotic distinctions to which Applicants refer ... are not at issue in this case." Office Action of April 21, 2006, at page 28. However, as shown by the Storkus Declaration, these differences are at the *very heart* of why one of skill in the art would

not have had a reasonable expectation of success in combining Waterhouse with Rowlands and Zauderer. *See* Storkus Declaration at paragraphs 7-9.

In particular, Dr. Storkus stated: 1) that he thought that it would not be practical to screen the number of eukaryotic cells necessary to find antigen-specific antibodies, as was possible via screening phage; and 2) because of the differences in the conditions of eukaryotic cytoplasm as compared to prokaryotic periplasm, he thought that random pairs of immunoglobulin heavy and light chains would fail to associate properly in eukaryotic cells and therefore would not allow selection of antigen-specific antibodies. *Id.* at paragraph 7. Dr. Storkus further explained that expressing a single antibody, as in Rowlands, is "far simpler" than expressing heavy and light chain pairs from separate libraries, because the Rowlands antibody had already been selected for heavy and light chains that paired correctly and efficiently to specifically bind antigen. *Id.* at paragraph 9. Dr. Storkus also explicitly stated that Zauderer does not address the concern of assembling heavy and light chains from two *separate* libraries in eukaryotic cells because only one library was introduced into host cells. *Id.* Therefore, Dr. Storkus concluded that his expectations would not have changed in view of these references. *Id.*

The Examiner has provided no specific evidence or relevant scientific rationale to counter the statements of Dr. Storkus or support the erroneous assumption that, simply because two libraries had been used for phage display in prokaryotic cells, one of skill in the art would expect the claimed two-library screening/expression system to be successful in eukaryotic cells. Indeed, the only "evidence" cited by the Examiner are passages from Rowlands, Zauderer, and Waterhouse, and a few paragraphs from Appellants' own specification that mention phage display methods (and, more

specifically, the shortcomings of phage display methods). *See* 10/31/06 Office Action at pages 22-23 and 29. Dr. Storkus gave explicit reasons why he did not think there was a reasonable expectation of success, even in view of Rowlands, Zauderer, and Waterhouse. Hence, citing excerpts from these references does not lend support to the Examiner's position. Likewise, the cited paragraphs from Appellants' own specification do not support the Examiner's position because Appellants do not dispute the fact that combinatorial libraries for selecting immunoglobulins have been generated using bacteriophage. Rather, the relevant inquiry is whether one of skill in the art would have had been motivated to combine Rowlands, Zauderer, and a phage display reference like Waterhouse to arrive at the claimed invention *with a reasonable expectation of success*. Dr. Storkus explained why he, in his opinion as an immunology expert who evaluated the claimed technology at the time the present application was filed, did not think there was a reasonable expectation of success at that time. By disregarding Dr. Storkus's explanation without providing any supporting evidence to contrary, the Examiner has improperly substituted his own opinion for that of an expert.

In addition, the Examiner erred factually by contending that the Storkus Declaration is "ambiguous," and that Dr. Storkus did not specify the time at which the idea for the present invention was first presented to him. *See* 10/31/06 Office Action at page 30. It is clear from his Declaration that the idea was presented to Dr. Storkus in his capacity as an SAB member of Vaccinex, Inc., and that he was an SAB member at the time the present application was filed (*i.e.*, from 2001 to 2004). *See* Storkus Declaration at pages 1-2.



One of ordinary skill in the art would not have expected that, simply because Waterhouse *et al.* had developed a method of screening antibody fragments fused to phage particles in *bacterial host cells*, the same thing could be done with two separate libraries of vaccinia viruses in *eukaryotic host cells*. There simply is not sufficient guidance in any of the cited references to indicate how one of ordinary skill in the art would have combined them with a reasonable expectation of success. Furthermore, the Examiner has not pointed to any evidence other than Appellants' own specification to suggest that there was a reasonable expectation of success; but this is an improper source for this expectation. *See, e.g., In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438. As such, the Examiner has not established a *prima facie* case of obviousness.

**(b) *The Examiner has not Considered the Claimed Invention as a Whole and is Using Impermissible Hindsight***

It is well established that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) Furthermore, "rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" *In re Rouffet*, 149 F.3d 1350, 1375 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) (quoting *Sensonics, Inc. v. Aerosonic Corp.* 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed. Cir. 1996).

It is also well established that the invention must be considered "as a whole," and that the Examiner cannot merely focus on the obviousness of differences and substitutions between the claimed invention and the cited references to establish a *prima facie* case of obviousness. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 92 (Fed. Cir. 1986) ("Focusing on the obviousness of substitutions and differences instead of on the invention as a whole as the district court did in frequently describing the claimed invention as *the mere substitution of monoclonal for polyclonal antibodies in a sandwich assay*, was a legally improper way to simplify the difficult determination of obviousness." (emphasis added)).

In the instant case, the Examiner has distilled the claimed invention to its gist of "a method of selecting an antibody from two expression libraries" Using this "gist" of the invention, the Examiner has selectively picked individual elements of the claimed invention from the cited references to assert a *prima facie* case of obviousness. In doing so, however, the Examiner has used impermissible hindsight and failed to consider the claimed invention as a whole. The claimed invention requires the introduction into mammalian cells of two libraries of vaccinia virus vectors, one encoding immunoglobulin heavy chains and one encoding immunoglobulin light chains, wherein the expressed immunoglobulin chains can combine to form immunoglobulin molecules, thus permitting expression of immunoglobulin molecules from mammalian host cells. The cited references do not teach or suggest the claimed invention *as a whole*.

Rowlands discloses expression of a pre-selected Campath-1H antibody by introducing into a mammalian host cell a single, pre-selected Campath 1-H heavy chain and a single, pre-selected Campath-1H light chain in vaccinia virus vectors. However,

Rowlands does not teach expression of a *library* of heavy chains and a *library* of light chains, so the Examiner relies on Zauderer for the feature of expressing a library of vaccinia virus vectors. *See* Office Action at pages 5-6. But this combination still does not teach all elements of the claimed invention because it does not teach that *two* vaccinia virus libraries of *immunoglobulin heavy and light chains* are introduced and expressed in mammalian host cells. *See id.* Therefore, the Examiner relies on Waterhouse as a tertiary reference, stating that it discloses screening of two libraries of immunoglobulin heavy and light chains. *See id.* at page 6. However, of significant importance, the Waterhouse method uses bacteriophage vectors introduced into *prokaryotic* bacterial host cells, which is a key difference from the claimed invention.

The Examiner has focused on this difference between the claimed invention and the combination of the Rowlands and Zauderer references and merely substituted the feature of two expression libraries from Waterhouse to “fill in” the missing element from the Rowlands/Zauderer combination. However, as established in *Hybritech*, this type of simple substitution of elements is an improper analysis for establishing a *prima facie* case of obviousness. Furthermore, this substitution relies on an improper distillation of the invention down to its gist of “a method of selecting an antibody from two expression libraries,” since it ignores the fact that the Waterhouse immunoglobulin libraries are *prokaryotic* phage display libraries and the claimed invention requires two *eukaryotic* expression libraries.

As indicated in the declarations of Dr. Storkus (Exhibit 4) and Dr. Maurice Zauderer (submitted herewith as Exhibit 5), the expression of antibody fragments in prokaryotic phage display libraries is fundamentally different from the expression of

immunoglobulins from two eukaryotic libraries and, therefore, the success of the prokaryotic system would not have been predictive of the success of the eukaryotic system. For example, at the time the present application was filed, Dr. Storkus thought that antigen-specific antibodies of interest would not occur at a sufficiently high frequency when expressed from two random libraries of heavy and light chains to permit their identification within the screening throughput parameters of eukaryotic cells. Storkus Declaration at page 3. Also, both Dr. Storkus and Dr. Zauderer indicated that prokaryotic cells and eukaryotic cells would provide different environments for the pairing of immunoglobulin heavy and light chains. Specifically, Dr. Storkus stated that "antibody fragments expressed in phage, whether or not covalently linked, concentrate and are assembled in the periplasmic space." Storkus Declaration at pages 3-4, paragraph 7. Likewise, Dr. Zauderer indicated that one of ordinary skill in the art would not have considered the Waterhouse improvements to phage display methods, *e.g.*, *lox-Cre* recombination of heavy and light chains to allow for simultaneous co-selection from the same prokaryotic host, "as features that could be expanded for use in eukaryotic systems." Zauderer Declaration at pages 6-7. Thus, although immunoglobulin fragments could pair together when concentrated in the periplasmic space of a bacterium, the skilled artisan would not have thought to combine Rowlands and Zauderer with Waterhouse because it would not have been predictable that separately expressed heavy and light chains from two random vaccinia libraries would find each other in the eukaryotic cytoplasm and pair together with sufficient frequency to form antigen-specific immunoglobulins. It is only by using the claimed invention itself as a roadmap that the Examiner has found the claimed invention to be obvious over this combination of references.

At the very most, the combination of Rowlands, Zauderer, and Waterhouse might be an *invitation to try* introducing two expression libraries of immunoglobulin chains in eukaryotic host cells, "but [the cited references] do not suggest how that end might be accomplished." *See e.g., Hybritech* 802 F.2d at 1380, 231 USPQ at 91. Furthermore, it is well known that "obvious to try" is not the standard for establishing a *prima facie* case of obviousness under 35 U.S.C. § 103. *See e.g., id.*

Accordingly, the Examiner has failed to make a *prima facie* showing of obviousness.

**5. *Supplemental Section: Applicant's Arguments of Non-Obviousness of the Claimed Invention are Supported by Recent Case Law***

As discussed in the Legal Principles section, *supra*, the United States Supreme Court recently addressed the issue of obviousness in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). This decision was rendered after Appellants originally filed their Brief on Appeal on April 27, 2007, which set forth arguments of why the claimed invention is not obvious over the prior art. Appellants are therefore providing this supplemental section to the Brief on Appeal to emphasize that their position regarding the non-obviousness of the claimed invention as set forth in the preceding sections remains valid and, indeed, is reinforced by the Supreme Court's decision in *KSR*.

As discussed in the Legal Principles section, *supra*, the Supreme Court in *KSR*, determined that the teaching-suggestion-motivation ("TSM") approach to an obviousness inquiry is not inconsistent with an obviousness analysis under *Graham v. John Deere Co.*, that there must be a reason or rationale behind an obviousness determination, and "this analysis should be made explicit." *KSR* at 1741 (citing *In re Kahn*, 441 F.3d 977,

988 (Fed. Cir. 2006)). As also set forth, *supra*, the Federal Circuit recognized and applied this requirement in *Takeda Chemical Industries, Ltd. v. Alphapharm PTY., LTD*, No. 06-1329, slip op. (Fed. Cir. 2007). In *Takeda*, Federal Circuit conducted an obviousness analysis in view of *KSR* and determined that there was no *prima facie* case of obviousness because: 1) there was no motivation based on the prior art as a whole to modify the closest prior art compound and arrive at the claimed compound, *Takeda* at 13-16; and 2) even if there had been a reason in the art to make the modification, the evidence indicated that there was no reasonable expectation of success in achieving the claimed invention. *Id.* at 17-18.

These recent decisions are completely consistent with Appellants' arguments of non-obviousness. In the present case, Appellants provided the Declaration of Dr. Walter Storkus, an expert in immunology, which states precise reasons why one of ordinary skill in the art would not have had a reasonable expectation of success in combining the cited references. *See, e.g.*, Section VII.A.4., *supra*; *see also* Declaration of Dr. Walter Storkus (submitted as Exhibit 4 with the Brief on Appeal filed on April 27, 2007). As explained in detail above, the Examiner has not provided any specific evidence or relevant scientific rationale to counter the statements of Dr. Storkus and show that one of ordinary skill in the art would have had a reasonable expectation of success. *KSR* did not dispense with the requirement for providing a credible rationale for why one of ordinary skill in the art would have combined elements in the prior art and showing that there would have been a reasonable expectation of success, particularly when Appellants have provided evidence to the contrary. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

Moreover, as set forth in detail in Section VII.A.4.(b)., *supra*, the Examiner in the present case failed to consider the claimed invention as a whole when making the obviousness rejection of the claims. The requirement to consider the claimed invention as a whole is a statutory mandate that remains unaffected by the Supreme Court's decision in *KSR*. See 35 U.S.C. § 103(a) ("A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that *the subject matter as a whole* would have been obvious at the time the invention was made . . . ." (emphasis added)). In the present case, this mandate was not met, and the Examiner therefore failed to establish a *prima facie* case of obviousness.

In *Takeda*, the Federal Circuit also distinguished their previous decision in *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348 (Fed. Cir. 2007), which was decided before *KSR*. See *Takeda*, slip op. at 15-16. In *Pfizer*, the Federal Circuit held that claims directed to the besylate salt of amlodipine would have been obvious in view of a prior art patent that generically disclosed salts of amlodipine and a prior art article disclosing 53 FDA-approved anions that are useful for making pharmaceutically active salts, including the one used for making a besylate salt. *Id.* The *Pfizer* court determined that there was a motivation to combine these references because there was evidence that one of ordinary skill in the art would have favorably considered the besylate salt over the other anions on the list, due to its particular properties and because numerous other prior art references identified the preference for besylate salts. *Id.* at 1363. The *Pfizer* court also determined that there was a reasonable expectation of success, analogizing the case "to the optimization of a range or other variable within the claims that flows from the 'normal

desire of scientists or artisans to improve upon what is already generally known.'" *Id.* at 1368 (quoting *In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003). However, as pointed out by the court in *Takeda*, the Federal Circuit was careful to note that *Pfizer*, as with all obviousness determinations, was decided on its *particularized facts*. See *Pfizer*, 480 F.3d at 1367; *Takeda*, slip op. at 16. Thus, as demonstrated in *Takeda*, there is no general rule that modifications of chemical structure are obvious *per se*.

Unlike *Pfizer*, the present invention was not derived by merely "optimizing" or "tweaking" certain known parameters of a prior art method. For example, Dr. Storkus's Declaration explained why, even though the use of two immunoglobulin libraries for phage display in prokaryotic hosts was known, this was not at all predictive of the success of introducing two immunoglobulin libraries into eukaryotic host cells to select antigen-specific antibodies. See Exhibit 4. Likewise, Dr. Storkus explained that the expression of a single, preselected antibody in a eukaryotic host cell would not have provided a reasonable expectation of success for the association of random pairs of immunoglobulin heavy and light chains from two separate libraries in the eukaryotic cytoplasm. See *id.* Hence, unlike *Pfizer*, the art did not provide any guidance that would have led one of ordinary skill to the methods of the present invention with a reasonable expectation of success.

Hence, Appellants' arguments made in this Brief and during the course of prosecution of the captioned application are completely consistent with the Supreme Court's decision in *KSR* as well as with the Federal Circuit's recent decisions regarding obviousness.



**6. *Claims 84, 88-97, 99, 103, 107-122, and 129-131 are not Unpatentable for Non-statutory Double Patenting***

Claims 84, 88-97, 99, 103, 107-122, and 129-131 are not unpatentable under the doctrine of non-statutory obviousness-type double patenting over claims 1-84 of U.S. Patent Application Serial No. 10/052,942 ("the '942 application"), in view of Rowlands, or over claims 46-128 of U.S. Patent Application Serial No. 10/465,808 ("the '808 application"), in view of Rowlands and Zauderer.

Appellants respectfully request that these rejections be held in abeyance until the remaining issues outstanding in this application have been resolved.

In addition, Appellants note that the '942 application was filed on January 23, 2002, and the '808 application was filed on June 20, 2003, while the present application was filed on November 14, 2001. According to the MPEP § 804.I.B.1 (pg. 800-17):

If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

Thus, if the nonstatutory obviousness-type double patenting rejection over the '942 application, in view of Rowlands is the only rejection remaining in the above-captioned application (*i.e.*, the "earlier filed of the two pending applications"), the double patenting rejection should be withdrawn without the need for a terminal disclaimer. Likewise, if the nonstatutory obviousness-type double patenting rejection over the '808 application, in view of Rowlands and Zauderer is the only rejection remaining in the above-

captioned application (*i.e.*, the "earlier filed of the two pending applications"), this double patenting rejection should also be withdrawn without the need for a terminal disclaimer.

***B. Conclusions***

In view of the foregoing discussion, Appellants submit that the subject matter of claims 84, 88-97, 99, 103, 107-122, and 129-131 would not have been obvious over the cited references. The Examiner has failed to establish that, when considering the claimed invention as a whole and without the use of impermissible hindsight, all of the elements of the claims are taught or suggested by the cited references. The Examiner has also failed to provide legally and factually sufficient evidence as to why a person of ordinary skill in the art would have been motivated to modify or combine the references with a reasonable expectation of success. Thus, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established.

Appellants also submit that, if the nonstatutory obviousness-type double patenting rejection of claims 84, 88-97, 99, 103, 107-122, and 129-131 over the '942 application, in view of Rowlands or over the '808 application in view of Rowlands and Zauderer are the only rejections remaining in the above-captioned application, the double patenting rejections should be withdrawn without the need for terminal disclaimers.

Accordingly, Appellants respectfully request that the Board reverse the Examiner's obviousness and obviousness-type double patenting rejections and remand this application for issue.

Respectfully submitted,

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### ***VIII. Claims Appendix***

84 (previously presented). A method of selecting polynucleotides which encode an antigen-specific human immunoglobulin molecule, comprising:

(a) introducing into a population of mammalian host cells capable of expressing said immunoglobulin molecule and permissive for vaccinia virus infectivity, a first library of polynucleotides encoding, through operable association with a transcriptional control region, a plurality of first immunoglobulin subunit polypeptides, each first immunoglobulin subunit polypeptide comprising:

(i) a first immunoglobulin constant region selected from the group consisting of a heavy chain constant region and a light chain constant region,

(ii) an immunoglobulin variable region selected from the group consisting of a heavy chain variable region and a light chain variable region, wherein said variable region corresponds to said first constant region, and

(iii) a signal peptide capable of directing cell surface expression or secretion of said first immunoglobulin subunit polypeptide,

wherein said first library is constructed in a vaccinia virus vector, provided said first library is not constructed by traditional homologous recombination;

(b) introducing into said host cells a second library of polynucleotides encoding, through operable association with a transcriptional control region, a plurality of second immunoglobulin subunit polypeptides, each comprising:

(i) a second immunoglobulin constant region selected from the group consisting of a heavy chain constant region and a light chain constant region,

wherein said second immunoglobulin constant region is not the same as said first immunoglobulin constant region,

(ii) an immunoglobulin variable region selected from the group consisting of a heavy chain variable region and a light chain variable region, wherein said variable region corresponds to said second constant region, and

(iii) a signal peptide capable of directing cell surface expression or secretion of said second immunoglobulin subunit polypeptide,

wherein said second immunoglobulin subunit polypeptide is capable of combining with said first immunoglobulin subunit polypeptide to form an immunoglobulin molecule, and wherein said second library is constructed in a vaccinia virus vector, provided said second library is not constructed by traditional homologous recombination;

(c) permitting expression of immunoglobulin molecules, from said host cells;

(d) contacting said immunoglobulin molecules with an antigen and detecting specific antigen-antibody complexes; and

(e) recovering vaccinia virus vectors containing polynucleotides of said first library which encode immunoglobulin subunit polypeptides which, as part of an immunoglobulin molecule, are specific for said antigen.

88 (previously presented). The method of claim 84, further comprising isolating the immunoglobulin subunit polypeptide-encoding polynucleotides contained in the vaccinia virus vectors recovered from said first library.

89 (previously presented). The method of claim 88, further comprising:

(k) introducing into a population of mammalian host cells capable of expressing said immunoglobulin molecule and permissive for vaccinia virus infectivity vaccinia virus vectors containing said second library of polynucleotides, wherein said vaccinia virus vectors are infectious;

(l) introducing into said host cells vaccinia virus vectors containing those polynucleotides isolated from said first library, wherein the vaccinia virus vectors containing said isolated polynucleotides are rendered incapable of producing infectious vaccinia virus vectors in said host cells;

(m) permitting expression of immunoglobulin molecules from said host cells;

(n) contacting said immunoglobulin with said specific antigen and detecting specific antigen-antibody complexes; and

(o) recovering vaccinia virus vectors containing polynucleotides of said second library which encode immunoglobulin subunit polypeptides which, as part of an immunoglobulin molecule, are specific for said antigen.

90 (previously presented). The method of claim 89, further comprising:

(p) introducing the vaccinia virus vectors recovered in (o) into a population of mammalian host cells capable of expressing said immunoglobulin molecule and permissive for vaccinia virus infectivity;

(q) introducing into said host cells vaccinia virus vectors containing those polynucleotides isolated from said first library, wherein the vaccinia virus vectors

containing said isolated polynucleotides are rendered incapable of producing infectious vaccinia virus virions in said host cells;

(r) permitting expression of immunoglobulin molecules from said host cells;

(s) contacting said immunoglobulin molecules with said antigen and detecting specific antigen-antibody complexes; and

(t) recovering vaccinia virus vectors containing polynucleotides of said second library which encode immunoglobulin subunit polypeptides which, as part of an immunoglobulin molecule, are specific for said antigen.

91 (previously presented). The method of claim 90, further comprising repeating steps (p)-(t) one or more times, thereby enriching for polynucleotides of said second library which encode a second immunoglobulin subunit polypeptide which, as part of an immunoglobulin molecule, specifically binds said antigen.

92 (previously presented). The method of claim 91, further comprising isolating the immunoglobulin subunit polypeptide-encoding polynucleotides contained in the vaccinia virus vectors recovered from said second library.

93 (previously presented). A method of producing a first polynucleotide and a second polynucleotide which encode an antigen-specific human immunoglobulin molecule comprising combining a first polynucleotide and a second polynucleotide isolated according to claim 92.

94 (previously presented). A method of producing a host cell which expresses an antigen-specific human immunoglobulin molecule comprising introducing the first and second polynucleotides produced as recited in claim 93 into a mammalian host cell capable of expressing said first and second polynucleotides.

95 (previously presented). A method of producing an antigen-specific human immunoglobulin molecule comprising:

culturing a host cell produced according to the method of claim 94 under conditions wherein said first and second polynucleotides are expressed; and

recovering said antigen-specific human immunoglobulin molecule.

96 (previously presented). The method of claim 84, wherein said plurality of first immunoglobulin subunit polypeptides are immunoglobulin heavy chains.

97 (previously presented). The method of claim 84, wherein said plurality of first immunoglobulin subunit polypeptides are immunoglobulin light chains.

99 (previously presented). The method of claim 89, wherein said host cells are infected with said second library at an MOI ranging from about 1 to about 10.



103 (previously presented). The method of claim 84, wherein said transcriptional control region comprises a T7 phage promoter active in cells in which T7 RNA polymerase is expressed.

107 (previously presented). The method of claim 84, wherein said first library of polynucleotides is constructed by a method comprising:

(a) cleaving an isolated vaccinia virus genome to produce a first viral fragment and a second viral fragment, wherein said first fragment is nonhomologous with said second fragment;

(b) providing a population of transfer plasmids comprising said polynucleotides which encode said plurality of immunoglobulin heavy or light chains, or fragments thereof through operable association with a transcription control region, flanked by a 5' flanking region and a 3' flanking region, wherein said 5' flanking region is homologous to a terminal portion of said first viral fragment and said 3' flanking region is homologous to a terminal portion of said second viral fragment; and wherein said transfer plasmids are capable of homologous recombination with said first and second viral fragments such that a viable vaccinia virus genome is formed;

(c) introducing said transfer plasmids and said first and second viral fragments into a mammalian host cell permissive for vaccinia virus infectivity under conditions wherein said transfer plasmids and said viral fragments undergo in vivo homologous recombination, thereby producing a viable modified vaccinia virus genome comprising a polynucleotide which encodes an immunoglobulin heavy chain or an immunoglobulin light chain; and

(d) recovering said modified vaccinia virus genome.

108 (previously presented). The method of claim 107, wherein said vaccinia virus genome is selected from the group consisting of a v7.5/tk virus genome and a vEL/tk virus genome.

109 (previously presented). The method of claim 107, wherein said first viral fragment and said second viral fragment are generated by cleaving one or more unique restriction sites selected from the group consisting of a unique NotI restriction site, a unique ApaI restriction site, and a combination of a unique NotI restriction site and a unique ApaI restriction site, in the tk gene of said vaccinia virus genome.

110 (previously presented). The method of claim 84, wherein said second library of polynucleotides is constructed by a method comprising:

(a) cleaving an isolated vaccinia virus genome to produce a first viral fragment and a second viral fragment, wherein said first fragment is nonhomologous with said second fragment;

(b) providing a population of transfer plasmids comprising said polynucleotides which encode said plurality of immunoglobulin light or heavy chains, or fragments thereof through operable association with a transcription control region, flanked by a 5' flanking region and a 3' flanking region, wherein said 5' flanking region is homologous to a terminal portion of said first viral fragment and said 3' flanking region is homologous to a terminal portion of said second viral fragment; and wherein said

transfer plasmids are capable of homologous recombination with said first and second viral fragments such that a viable vaccinia virus genome is formed;

(c) introducing said transfer plasmids and said first and second viral fragments into a mammalian host cell permissive for vaccinia virus infectivity under conditions wherein said transfer plasmids and said viral fragments undergo homologous recombination, thereby producing a viable modified vaccinia virus genome comprising a polynucleotide which encodes an immunoglobulin light chain or an immunoglobulin heavy chain; and

(d) recovering said modified vaccinia virus genome.

111 (previously presented). The method of claim 110, wherein said vaccinia virus genome is selected from the group consisting of a v7.5/tk virus genome and a vEL/tk virus genome.

112 (previously presented). The method of claim 110, wherein said first viral fragment and said second viral fragment are generated by cleaving one or more unique restriction sites selected from the group consisting of a unique NotI restriction site, a unique ApaI restriction site, and a combination of a unique NotI restriction site and a unique ApaI restriction site, in the tk gene of said vaccinia virus genome.

113 (previously presented). The method of claim 96, wherein said immunoglobulin heavy chains are a secreted form of an immunoglobulin heavy chain.

114 (previously presented). The method of claim 113,

wherein vaccinia virus vectors containing said first library of polynucleotides are divided into a plurality of virus pools, and each virus pool is infected into a separate population of mammalian host cells to form a plurality of host cell pools;

wherein said host cell pools are cultured such that immunoglobulin molecules are expressed and secreted into the culture medium containing said host cell pools to form a plurality of immunoglobulin pools;

wherein said immunoglobulin pools are contacted with said antigen, and specific antigen-antibody complexes are detected; and

wherein vaccinia virus vectors are recovered from those host cell pools which expressed immunoglobulin pools from which specific antigen-antibody complexes were detected.

115 (previously presented). The method of claim 114, further comprising:

(a) dividing said recovered vaccinia virus vectors into a plurality of virus sub-pools and infecting each virus sub-pool into a separate population of mammalian host cells to form a plurality of host cell sub-pools;

(b) culturing said host cell sub-pools such that immunoglobulin molecules are expressed and secreted into the culture medium containing said host cell sub-pools to form a plurality of immunoglobulin sub-pools;

(c) contacting said immunoglobulin sub-pools with said antigen, and detecting specific antigen-antibody complexes; and

(d) recovering vaccinia virus vectors from those host cell sub-pools which expressed immunoglobulin sub-pools from which specific antigen antibody complexes were detected.

116 (previously presented). The method of claim 115, further comprising repeating steps (a)-(d) one or more times, thereby enriching for polynucleotides of said first library which encode a first immunoglobulin subunit polypeptide which, as part of an immunoglobulin molecule specifically binds said antigen.

117 (previously presented). The method of claim 97, wherein said second immunoglobulin subunit polypeptides are a secreted form of an immunoglobulin heavy chain.

118 (previously presented). The method of claim 117,  
wherein vaccinia virus vectors containing said first library of polynucleotides are divided into a plurality of virus pools, and each virus pool is infected into a separate population of mammalian host cells to form a plurality of host cell pools;

wherein said host cell pools are cultured such that immunoglobulin molecules are expressed and secreted into the culture medium containing said host cell pools to form a plurality of immunoglobulin pools;

wherein said immunoglobulin pools are contacted with said antigen, and specific antigen-antibody complexes are detected; and

wherein vaccinia virus vectors are recovered from those host cell pools which expressed immunoglobulin pools from which specific antigen antibody complexes were detected.

119 (previously presented). The method of claim 118, further comprising:

(a) dividing said recovered vaccinia virus vectors into a plurality of virus sub-pools and infecting each virus sub-pool into a separate population of mammalian host cells to form a plurality of host cell sub-pools;

(b) culturing said host cell sub-pools such that immunoglobulin molecules are expressed and secreted into the culture medium containing said host cell sub-pools to form a plurality of immunoglobulin sub-pools;

(c) contacting said immunoglobulin sub-pools with said antigen, and detecting specific antigen-antibody complexes; and

(d) recovering vaccinia virus vectors from those host cell sub-pools which expressed immunoglobulin sub-pools from which specific antigen antibody complexes were detected.

120 (previously presented). The method of claim 119, further comprising repeating steps (a)-(d) one or more times, thereby enriching for polynucleotides of said first library which encode a first immunoglobulin subunit polypeptide which, as part of an immunoglobulin molecule specifically binds said antigen.

121 (previously presented). The method of claim 114, wherein said detecting is by ELISA.

122 (previously presented). The method of claim 118, wherein said detecting is by ELISA.

129 (previously presented). The method of claim 84, wherein step (e) further comprises recovering vaccinia virus vectors containing polynucleotides of said second library which encode immunoglobulin subunit polypeptides which, as part of an immunoglobulin molecule are specific for said antigen.

130 (previously presented). The method of claim 129, further comprising isolating the immunoglobulin subunit polypeptide-encoding polynucleotides contained in the vaccinia virus vectors recovered from said second library.

131 (previously presented). A method of producing a first polynucleotide and a second polynucleotide which encode an antigen-specific human immunoglobulin molecule comprising combining a first polynucleotide and a second polynucleotide isolated according to claim 130.

**IX. Evidence Appendix**

<b>Exhibit</b>	<b>Title of Exhibit</b>	<b>Location in Record</b>
Exhibit 1	Rowlands <i>et al.</i> , PCT Publication No. WO 93/01296	Submitted in an Information Disclosure Statement filed by Applicants on November 6, 2002, and first cited by Examiner in Office Action dated September 7, 2004.
Exhibit 2	Zauderer, PCT Publication No. WO 00/28016	Submitted in an Information Disclosure Statement filed by Applicants on May 28, 2002, and first cited by Examiner in Office Action dated September 7, 2004.
Exhibit 3	Waterhouse <i>et al.</i> , <i>Nuc. Acids Res.</i> 21: 2265-66 (1993)	Submitted in an Information Disclosure Statement filed by Applicants on May 1, 2003, and first cited by Examiner in Office Action dated September 7, 2004.
Exhibit 4	Declaration under 37 C.F.R. § 1.132 of Dr. Walter J. Storkus, including accompanying documents: <ul style="list-style-type: none"> <li>▪ <i>Curriculum vitae</i> of Dr. Storkus</li> <li>▪ "Monoclonal Antibody Partnerships in the Biopharmaceutical Industry," excerpts from L.E.K. consulting report (2001).</li> <li>▪ H. J. de Haard <i>et al.</i>, <i>J. Biol. Chem.</i> 274:18218-18230 (1999).</li> </ul>	Submitted by Applicants with the Reply filed on July 21, 2005.
Exhibit 5	Declaration under 37 C.F.R. § 1.132 of Dr. Maurice Zauderer, including accompanying documents: <ul style="list-style-type: none"> <li>▪ <i>Curriculum vitae</i> of Dr. Zauderer</li> <li>▪ Press releases of business alliances with Vaccinex, Inc.</li> </ul>	Submitted by Applicants with the Reply filed on July 21, 2005.



***X. Related Proceedings Appendix***

No decisions have been rendered by a court or the Board in any related proceeding.